

Notice of Allowability

Application No.

10/672,683

Applicant(s)

LIN ET AL.

Examiner

Art Unit

Raymond J. Henley III

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to July 28, 2005.
2. ☒ The allowed claim(s) is/are 19-27.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

RAYMOND HENLEY III
PRIMARY EXAMINER

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EXAMINER'S AMENDMENT/REASONS FOR ALLOWANCE

An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee

The amendment has been made to correct and obvious informality regarding priority under §119(e).

In Applicants' amendment filed September 26, 2003, lines 1-2, the expression "filed September 26, 2003" has been changed to read ---September 26, 2002---

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

Representative of the presently claimed invention is found in claim 19 which reads:

"19. (currently amended) A method for enhancing the inhibitory activity of an anticancer drug in cervical carcinoma cells, hepatocellular carcinoma cells, or breast cancer cells, comprising administering to the cells abietic acid or dehydroabietic acid in combination with an anticancer drug."

The closest prior art is Saxena et al. (U.S. Patent Application Publication US 2003/0092674 A1) which is directed to, *inter alia*, the oral administration of a composition which comprises one or more abietic acid derivatives (page 3, sections [0019], [0020], [0022] and [0023]; page 4, sections [0026] and [0027]; and pages 10+ at claim 1) and a pharmaceutically acceptable carrier for the cancers including breast, cervix, i.e., cervical and liver, i.e., hepatic which would necessarily include hepatocellular (see page 17, claim 7 at lines 15, 18, 20 and 21 thereof). Conspicuously absent from Saxena is a teaching or suggestion of additionally administering, by any route, "an anticancer drug". Therefore, Saxena provides no

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explicit motivation for one of ordinary skill in the art to additionally administer an anticancer drug.

As provided for by the MPEP § 2144.06, under the heading “Substituting Equivalents for the Same Purpose”, it is stated :”In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents. In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)”(emphasis added).

Further provided for in the MPEP § 2144.06 is "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted).

However, and more importantly, the MPEP § 2144.08 (II) states, “Use of per se rules by Office personnel is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. 103. See, e.g., In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).

Lacking at least some teaching or suggestion in Saxena et al. to concomitantly administer abietic acid or dehydroabietyic acid and an anticancer drug for the purposes claimed, i.e., “for enhancing the inhibitory activity of an anticancer drug in cervical...hepatocellular...or breast

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cancer cells", (claim 19), or for "increasing the permeability of cervical...heptocellular...or breast cancer cells", (claim 25), therefore, would be a clear error on the part of the Examiner.

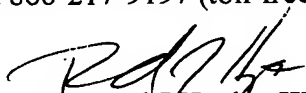
Accordingly, the Examiner finds claims 19-27 allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raymond J. Henley III
Primary Examiner
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September 30, 2005